

REMARKS

As an initial matter, Applicants thank the Examiner for taking the time to meet with Applicants' representative on June 1, 2006. During the interview, Applicants' representative reiterated their argument that "sports floor covering" is a term of art, including discussing further references that depict the various physical requirements of sports floors, and also argued that the claims are differentiable over the cited prior art. Applicants' representative also proposed the amendments to claim 18 as set forth above, and the Examiner indicated that it appeared that the proposed amendments to claim 18 would take the claims out of the scope of the '298 patent. Applicants appreciate this indication.

Claims 18-22, 24-28, 30, 32-34 and 37-38 stand rejected as being anticipated by U.S. Patent No. 5,912,298 to Gomi et al.; and claims 18-22 and 24-38 also stand rejected as being obvious over U.S. Patent No. 5,912,298 to Gomi et al.

Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections of the claims.

**1. Rejection of Claims 18-22 24-28, 30, 32-34 and 37-38  
under 35 U.S.C. § 102 (a or e)**

The Office Action states that claims 18-22, 24-28, 30, 32-34 and 37-38 are rejected under 35 U.S.C. §102 (a or e) as being anticipated by U.S. Patent No. 5,912,298 to Gomi et al. (the '298 patent) for the reasons set forth in the Office Action.

**RESPONSE**

Applicants respectfully traverse this rejection. The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants respectfully submit that the '298 patent fails to teach each of the claimed elements. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 18 as amended is currently drawn to a method for making sports floor coverings comprising applying a formulation to a

surface, said formulation comprising aqueous, isocyanate free polyurethane dispersions, wherein said dispersions have a solid matter content of  $\geq$  30 percent by weight and a solvent content of  $\leq$  10 percent by weight and wherein the polyurethane polymers of said dispersions; have a number average molecular mass of 25,000 to 100,000 Daltons, and are obtained from polyols and polyisocyanates having an NCO/OH equivalent ratio of 1.5 to 2.5 and by forming a polyurethane pre-adduct which is reacted with a lower molecular and anionic modifiable polyol with two or more hydroxy groups reactive with polyisocyanates and one or more carboxy groups inert with respect to polyisocyanates to produce a polyurethane prepolymer.

As was discussed during the interview, the '298 patent does not teach the features of claim 18, namely polyurethane dispersions obtained from polyols and polyisocyanates having an NCO/OH equivalent ratio of 1.5 to 2.5. The '298 patent is directed to a composition for floor polish made by a two-step process. However, the '298 patent does not teach preparing polyurethane dispersions obtained from polyols and polyisocyanates having the claimed equivalent ratio.

The '298 patent is generally silent with respect to the desired NCO/OH equivalent ratio within the recited inventive subject matter of the patent. However, turning to the embodiments

of the patent exemplified in the Examples, it is readily apparent that the '298 patent discloses NCO/OH equivalent ratios well outside the claimed range. Examples 1 and A-E of the '298 patent teach NCO/OH equivalent ratios ranging from 0.93 to 1.34. Thus, the '298 patent fails to teach this feature of claim 18.

In addition, in the embodiments exemplified in the Examples of the '298 patent, the solvent content is much higher than the presently claimed amount of less than or equal to 10% by weight. The amount of solvent disclosed in Examples 1 and A-E of the '298 patent range from 18.1 to 20.7, well outside the range claimed in claim 18. Therefore, the '298 patent also fails to teach an embodiment having a solvent content within the range claimed in claim 18.

Thus, Applicants respectfully submit that the '298 patent fails to teach each of the claimed features of claim 18, and therefore does not anticipate the claim. Likewise, the remaining claims depend from claim 18 and necessarily contain all of the features therein, and so the '298 patent also does not anticipate the dependent claims. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims as being anticipated by the '298 patent.

2. Rejection of Claims 18-22 and 24-38  
under 35 U.S.C. § 103(a)

The Official Action states that claims 18-22 and 24-38 are rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 5,912,298 to Gomi et al. (the "298 patent"). The reasons for the rejection are given in the Official Action.

**RESPONSE**

Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof. The reference of record does not teach or suggest applicants' inventive subject matter as a whole as recited in the claims. The Examiner has failed to establish a *prima facia* case of obviousness against the presently rejected claims.

To establish a *prima facia* case of obviousness, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage

point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference must teach or suggest all the limitations of the claims. *In re Wilson*, 165 U.S.P.Q.2d 494, 496 (C.C.P.A. 1970).

Claim 18 as amended is currently drawn to a method for making sports floor coverings comprising applying a formulation to a surface, said formulation comprising aqueous, isocyanate free polyurethane dispersions, wherein said dispersions have a solid matter content of  $\geq$  30 percent by weight and a solvent content of  $\leq$  10 percent by weight and wherein the polyurethane polymers of said dispersions; have a number average molecular mass of 25,000 to 100,000 Daltons, and are obtained from polyols and polyisocyanates having an NCO/OH equivalent ratio of 1.5 to 2.5 and by forming a polyurethane pre-adduct which is reacted with a lower molecular and anionic modifiable polyol with two or more hydroxy groups reactive with polyisocyanates and one or more carboxy groups inert with respect to polyisocyanates to produce a polyurethane prepolymer.

As is discussed above with respect to the anticipation rejection, the '298 patent does not teach the features of claim 18, namely polyurethane dispersions obtained from polyols and polyisocyanates having an NCO/OH equivalent ratio of 1.5 to 2.5.

The '298 patent is directed to a composition for floor polish made by a two-step process. However, the '298 patent does not teach preparing polyurethane dispersions obtained from polyols and polyisocyanates having the claimed equivalent ratio.

The '298 patent is generally silent with respect to the desired NCO/OH equivalent ratio within the recited inventive subject matter of the patent. However, the following table illustrates the NCO/OH equivalent ratios and solvent contents for each of Examples 1 and A-E of the '298 patent:

Example	1	A	B	C	D	E
NCO/OH	1.18	1.34	1.26	1.18	1.13	0.93
Solvent wt. %	19.6	20.7	20.2	19.6	18.8	18.1

As can be seen from this table, the polyurethane resins embodied within the '298 patent all have a much lower NCO/OH equivalent ratio than that currently claimed in claim 18. Thus, the '298 patent fails to teach this feature of claim 18.

In addition, it is also readily apparent from the above table that, in the embodiments exemplified in the Examples of the '298 patent, the solvent content is much higher than the presently claimed amount of less than or equal to 10% by weight. The amount

of solvent disclosed in Examples 1 and A-E of the '298 patent range from 18.1 to 20.7, well outside the range claimed in claim 18. Therefore, the '298 patent also fails to teach an embodiment having a solvent content within the range claimed in claim 18.

Furthermore, Applicants respectfully submit that there is no motivation or teaching within the '298 patent to use polyurethane resins with such high NCO/OH equivalent ratios. The high isocyanate amounts help provide crosslinking of the prepolymer in atmospheric conditions. The '298 patent, on the other hand, is concerned with reversible crosslinking because the composition, usable as a floor polish, must be reversible in order to be removable. The present compositions are not meant to be removable. Therefore, a skilled artisan would not be lead by the '298 patent to use polyols and polyisocyanates with such a high NCO/OH ratio.

Thus, Applicants respectfully submit that the '298 patent fails to teach each of the claimed features of claim 18, and does not contain a motivation to alter the reference in an attempt to achieve the presently claimed invention. Likewise, the remaining claims depend from claim 18 and necessarily contain all of the features therein.

Accordingly, Applicants respectfully submit that the Examiner has failed to prove a *prima facie* case of obviousness, and that

there is no motivation for a skilled artisan to modify the '298 patent. Therefore, Applicants respectfully submit that claims 18-22 and 24-38 are not obvious over the '298 patent. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 18-22 and 24-38.

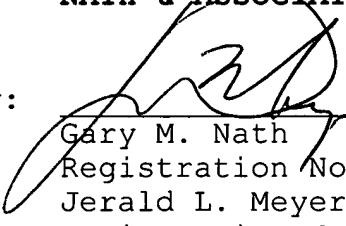
#### **CONCLUSION**

Claims 18-22 and 24-38 are currently pending in the present application. Applicants respectfully request the Examiner to reconsider and withdraw the rejections and allow all claims pending herein.

The Examiner is requested to contact the undersigned attorney if he has any questions or wishes to further discuss the merits of the presently pending claims.

Respectfully submitted,  
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